

Remarks

Applicants thank Examiner Avellino for the telephone conference on November 18, 2004 and for his thoughtful consideration of this case. This Application has been carefully reviewed in light of the Office Action mailed August 11, 2004. To clarify various aspects of inventive subject matter, Applicants amend Claims 1, 3-5, 19, 20, 27, 29-31, 42, 43, 48, 50-52, 57, 68, 75, and 76. Applicants also introduce new Claims 80-82 and cancel Claims 2, 28, and 49 without prejudice or disclaimer. To advance prosecution of this application, Applicants have responded to each notation by the Examiner. Applicants submit that all of the pending claims are allowable over the cited references. Applicants respectfully request reconsideration, further examination, and favorable action in this case.

Subject Matter Indicated as Allowable

Applicant notes with appreciation the Examiner's statement that Claim 61 contains allowable subject matter and would be allowed if rewritten in independent form. Applicants respectfully decline that invitation at this time, as amended independent Claim 48, from which Claim 61 depends, is believed to be patentable over the cited references.

Rejections under 35 U.S.C. § 112

The Examiner rejects Claims 1-79 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants have rewritten Claims 1, 3-5, 19, 20, 27, 29-31, 42, 43, 48, 50-52, 57, 68, 75, and 76. Applicants believe this amendment does not narrow the scope of the claim, but address the Examiner's rejections under §112. Applicants respectfully request reconsideration and favorable action in this case.

The Examiner also rejects Claim 16 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention because Applicants' use the term "approximately simultaneously." Applicants respectfully traverse this rejection for the reasons discussed below.

In particular, Applicants respectfully submit that the use of the term “approximately simultaneously” in this claim does not render the claim indefinite. Applicants note that the essential inquiry pertaining to the definiteness requirement with respect to relative terminology is “whether one of ordinary skill in the art would understand what is claimed, in light of the specification.” See M.P.E.P. §2173.05(b). Moreover, definiteness of claim language must be analyzed, not in a vacuum, but in light of: (a) the content of the specification; (b) the teachings of the prior art; and (c) the claim interpretation that would be given by one possessing ordinary skill in the art at the time the invention was made. M.P.E.P. § 2173.02. Applicants respectfully submit that the meaning of the term “approximately simultaneously” is sufficiently clear to one of ordinary skill in the art such that Claim 16 complies with 35 U.S.C. § 112, second paragraph.

Applicants respectfully submit that those of ordinary skill in the art would understand “approximately simultaneously” as recited in Claim 16 for example. Second, Applicants respectfully direct the Examiner’s attention to at least Page 26, Line 28 through Page 27, Line 7; and Page 28, Line 27 through Page 29, Line 5 of the Specification, which provide example embodiments of this claimed concept. For at least these reasons, Applicants respectfully submit that Claim 16 complies with 35 U.S.C. § 112, second paragraph. Thus, Applicants respectfully request reconsideration and favorable action in this case.

Interview Summary and Response to the Examiner’s Interview Summary

Applicants’ attorney conducted a telephonic conference with Examiner Avellino on November 18, 2004. On November 23, 2004, the Examiner submitted an Examiner’s Interview Summary. Pursuant to M.P.E.P. §713.04, Applicants submit the following comments to record Applicants’ understanding of the substance of the interview. If Applicants’ understanding is inaccurate, notice of such is appreciated.

During the interview, Applicants and the Examiner discussed 6,012,088 issued to Li et al. (“*Li*”) and independent Claims 1, 27, 48, and 68. Applicants understood at that time that, pending a further review of *Li* by the Examiner, amended independent Claims 1, 27, 48, and 68 appeared distinguishable from *Li*. Applicants understand that the Examiner has reserved any formal decision on this matter pending receipt of the formal claim amendments.

The Examiner Interview Summary inaccurately characterizes the Applicants' proposed amendment. In particular, Applicants did not propose to add language to any claims "such that the user is not prompted for any information in order to identify the virtual channel or protocol." Rather, Applicants suggested, with respect to independent Claims 1, 27, and 48 language specifying, for example, as recited in Claim 1, that the method automatically identifies "at least one of a valid virtual channel and a valid protocol for configuration with the customer premises equipment without prompting a user for information that directly or indirectly identifies the at least one of the valid virtual channel and the valid protocol."

Rejections under 35 U.S.C. § 102

The Examiner rejects Claims 1-5, 7-8, 20-21, 25-31, 33, 43-44, 46-52, 54-55, 57, 62-63, 67-69, 76-77, and 79 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,012,088 issued to Li et al. ("*Li*"). Applicants respectfully traverse these claim rejections for the reasons discussed below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he elements *must* be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q. 2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131 (emphasis added). Each of the numerous references cited by the Examiner fails to disclose, teach, or suggest, either expressly or inherently, various limitations recited in Claim 1.

a. Independent Claims 1, 27, and 48 are patentable over *Li*

As discussed during the interview, amended independent Claim 1 recites, in part, "automatically identifying at least one of a valid virtual channel and a valid protocol for configuration with the customer premises equipment without prompting a user for information that directly or indirectly identifies the at least one of the valid virtual channel and the valid protocol." As discussed during the interview, *Li* contains no disclosure of at

least these elements. For at least these reasons, Applicants respectfully requests withdrawal of the rejections and full allowance of amended Claim 1 and all claims depending therefrom.

As discussed during the interview, amended independent Claim 27 recites, in part, “automatically identifying at least one of a valid virtual channel and a valid protocol for configuration with the customer premises equipment without prompting a user for information that directly or indirectly identifies the at least one of the valid virtual channel and the valid protocol.” As discussed during the interview, *Li* contains no disclosure of at least these elements. For at least these reasons, Applicants respectfully requests withdrawal of the rejections and full allowance of amended Claim 27 and all claims depending therefrom.

As discussed during the interview, amended independent Claim 48 recites, in part, “a configuration manager operable to automatically identify at least one of a valid virtual channel and a valid protocol for configuration with the customer premises equipment without prompting a user for information that directly or indirectly identifies the at least one of the valid virtual channel and the valid protocol.” As discussed during the interview, *Li* contains no disclosure of at least these elements. For at least these reasons, Applicants respectfully requests withdrawal of the rejections and full allowance of amended Claim 48 and all claims depending therefrom.

b. Independent Claim 68 and new Claims 80-82 are patentable over *Li*

As discussed during the interview, amended independent Claim 68 recites, in part, “communicating over a virtual channel and toward a destination network element a probing configuration signal, the probing signal operable to identify at least one of a valid virtual channel and a valid protocol without retrieving an identification of the at least one of the valid virtual channel and the valid protocol from a memory storing that information.” As discussed during the interview, *Li* contains no disclosure of at least these elements. For at least these reasons, Applicants respectfully requests withdrawal of the rejections and full allowance of amended Claim 68 and all claims depending therefrom.

Applicants submit that new independent Claims 80-82 are patentable over *Li* for at least the reasons discussed above. Thus, Applicants respectfully request favorable action in this case with respect to Claims 80-82.

Applicants traverse the Examiner's suggestion that the phrase "memory that stores the identification" should be limited to "a predefined look-up table located on the customer premises equipment." *See Office Action at 5.* The M.P.E.P. sets forth a strict legal standard for claim interpretation. In particular, the M.P.E.P. provides that "[D]uring examination, the claims must be interpreted as broadly as their terms reasonably allow." M.P.E.P. §2111.01 citing *In re American Academy of Science Tech Center*, __ F.3d __, 2004 WL 1067528 (Fed. Cir. May 13, 2004). According to the M.P.E.P., "[T]his means that the words of the claim must be given their plain meaning unless the applicant has provided a clear definition in the specification." M.P.E.P. §2111.01. "One must bear in mind that, especially in nonchemical cases, the words of the claim are generally not limited by what is shown or disclosed in the specification." *Id.* "It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language." *Id.* citing *In re Vogel*, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970). Applicants submit that specification does not limit the term "memory that stores the identification" and, therefore, the phrase should be interpreted as broadly as the terms reasonably allow.

Rejections under 35 U.S.C. § 103

The Examiner rejects Claims 6, 9-12, 22-24, 32, 34-35, 45, 53, 64-66, and 67 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of what is known in the art. Claims 19, 42, and 75 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of "Official Notice." Claims 15-16, 18, 38-39, 41, 60, 70, and 72 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of U.S. Patent No. 6,122,287 issued to Ohanian et al. ("*Ohanian*"). The Examiner also rejects Claims 13-14, 17, 36-37, 40, 56, 58-59, 71, and 74 under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *Ohanian* in view of U.S. Patent No. 6,185,701 issued to Marullo et al. ("*Marullo*").

At the outset, Applicants note that the combination of *Li* in view of what is known in the art, in view of "Official Notice," in view of *Ohanian*, and in view of *Marullo* does not

teach automatically identifying “at least one of a valid virtual channel and a valid protocol for configuration with the customer premises equipment without prompting a user for information that directly or indirectly identifies the at least one of the valid virtual channel and the valid protocol” as recited in independent Claims 1, 27, and 48. Claims 3-26, 29-47, and 50-67 depending from those allowable claims are also in a condition of allowance. Moreover, Applicants note that the combination of *Li* in view of “Official Notice,” in view of *Ohanian*, and in view of *Marullo* does not teach that “the probing signal operable to identify at least one of a valid virtual channel and a valid protocol without retrieving an identification of the at least one of the valid virtual channel and the valid protocol from a memory storing that information” as recited in independent Claim 68. The claims that depend from Claim 68 are also patentable.

In addition, Applicants traverse the Examiner’s apparent reliance on common knowledge or his personal knowledge in rejecting several claims as being either obvious or considered known. *Office Action at 7-12*. For example, the Examiner provides that “Official Notice is taken that both the concept and advantages of providing for displaying the valid virtual channel or protocol to a user, receiving the user’s selection of the valid virtual channel or protocol, and configuring the customer premise equipment for operation using the selected virtual channel or protocol are well known and expected in the art.” *See Office Action at 12*.

While in limited circumstances an examiner may take official notice of facts not in the record or rely on “common knowledge” in making a rejection, “such rejections should be judiciously applied.” *See M.P.E.P. § 2144.03*. It is not appropriate for an examiner to take official notice of facts without citing a prior art reference “where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.” *Id.* (citing *In re Ahlert*, 165 U.S.P.Q. 418, 420-21 (C.C.P.A. 1970)). To the extent that the Examiner maintains these rejections based on “Official Notice,” “well-known art,” “common knowledge,” or other information within the Examiner’s personal knowledge, Applicants respectfully request that the Examiner cite a

reference as documentary evidence in support of these positions or provide an affidavit in accordance with M.P.E.P. § 2144.03 and 37 C.F.R. § 1.107.

Furthermore, the Examiner has not cited language in either the references or within information commonly known to those skilled in the art that provides the necessary motivation or suggestion to combine *Li* with “common knowledge,” *Ohanian*, and/or *Marullo*. The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. 2143.01. The “fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification. *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even clearer.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

¹ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).²

In the present case, the Examiner is improperly using the Applicants' disclosure as a blueprint for piecing together various elements of *Li*, "common knowledge," *Ohanian*, and/or *Marullo*. As provided above, the mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Thus, the mere fact that the teachings of one reference would improve the teachings of another reference as asserted by the Examiner does not provide the required suggestion to combine. The showing must be clear and particular. *See, e.g., C.R. Bard v. M3 Sys., Inc.*, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998). Without such independent suggestion, the art is to be considered as merely inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Agmen Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200 (Fed. Cir. 1991).

To reject the dependent claims under the proposed *Li*, "common knowledge," *Ohanian*, and/or *Marullo* combination, the Examiner has made conclusory "it would have been obvious" and "[a]n ordinary artisan would have been motivated" statements. For example, the Examiner has merely stated, with respect to Claim 15 "it would have been obvious" to make the proposed combination to "allow different networks using a plurality of protocols to transfer data the ability to discern which protocol is being used in order to transfer the data." *Office Action at 13*. The Examiner has presented no evidence, however, that suggests or motivates the combination. It is improper for the Examiner to use hindsight

² See also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.).

having read the Applicants' disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

Moreover, nothing in *Li*, the "common knowledge," *Ohanian*, and/or *Marullo* teaches, suggests, or motivates the proposed combination. Applicants respectfully submit that speculation in hindsight that it "would have been obvious" to make the proposed combination because the proposed modification would be helpful is insufficient under the M.P.E.P. and governing Federal Circuit case law.

Consequently, a *prima facie* case of obviousness cannot be maintained with respect to the rejected dependent claims, as the Examiner has not show the requisite proof necessary to establish a suggestion or motivation to combine the cited references.

No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the *Li*, *Ohanian*, and *Marullo* references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the anticipation and obviousness rejections.

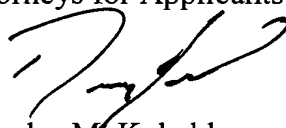
Conclusion

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending Claims. .

Applicants have enclosed checks for \$110.00 for a one-month extension of time and \$352.00 for additional claims. The Commissioner is hereby authorized to charge the additional extension fee of \$20.00 and the additional claims fee of \$248.00 to Deposit Account No. 02-0384 of Baker Botts L.L.P. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

If the Examiner feels that a conference would advance prosecution of this Application in any manner, Douglas M. Kubehl stands willing to conduct such a telephone interview at the convenience of the Examiner. Mr. Kubehl may be reached at 214-953-6486.

Respectfully submitted,
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